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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,697	01/24/2002	Tetsuya Matsui	381HI/50780	7835

7590 09/23/2005

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,697

Applicant(s)

MATSUI ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

A

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/2005 has been entered.

Response to Amendment

Amendment received on 8/12/2005 is acknowledged and entered. Claim 13 has been canceled. Claims 1-12 and 14-18 have been amended. Claims 1-18 are currently pending in the application.

Examiner's Note

Claims 5, 17 and 18. Examiner understands the phrase: "said release information is represented in graph format, table format, or with functional equations, or is represented by a combination of these formats for each equipment that is used in said certain process" as "said release information is represented in at least one of graph format, table format, or with functional equations, or is represented by a combination of these formats for each equipment that is used in said certain process".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Frankland et al. (US 2002/0026339 A1).

Frankland et al. (hereinafter Frankland) teaches a system for managing changes in regulatory requirements for business activities at an industrial facility, comprising:

Claim 1. A server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417], wherein said server is configured to set the release amounts to each release-transfer destination of chemical substances that compose said materials based on the types and input amounts of the materials that are input in a certain process, information for improving the environmental performance, according to information on these chemical substances that are released, the release amounts to each release-transfer destination of chemical substances that compose said materials and track hazardous materials and wastes, including movement and environmental releases [0417]; [0419]; evaluate environmental effects due to discharging the hazardous materials and wastes during the releases [0417]; [0419].

Claims 2. Said system, comprising: a database containing information on hazards associated with said materials, ecology-toxicity and environmental release information [0416]; [0417]. Information as to the specific content of said information does not recite a structural limitation and, therefore, is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*" Furthermore, Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of Claim 3 are disclosed in Frankland as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 3. Said system, including a database containing information including investment effectiveness including considering cost related to environmental health and safety regulations [0034]; [0037].

Claims 4, 15 and 16. Said system, comprising: a plurality of equipment; and said database contains information related to investment and environmental compliance effectiveness [0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claims 5, 17 and 18. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Claims 6-8. Said system, comprising: a server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417], wherein said system is configured to set the release amounts to each release-transfer destination of chemical substances that compose said materials based on the types and input amounts of the materials that are input in a certain process, and track hazardous materials and wastes, including movement and environmental releases [0417]; [0419]; evaluate environmental effects due to discharging the hazardous materials and wastes during the releases [0417]; [0419].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frankland et al. (US 2002/0026339 A1) in view of Fasca (US 2002/0065581 A1).

Claims 9 and 12. Frankland teaches a system and method for managing changes in regulatory requirements for business activities at an industrial facility, comprising:

identifying the chemical substances of the materials used [0416]; identifying environmental hazards associated with materials used [0416]; tracking hazardous materials and wastes, including movement and environmental releases [0417]; [0419]; evaluating environmental effects due to discharging the hazardous materials and wastes during the releases [0417]; [0419].

Frankland does not specifically teach evaluating equipment that reduces chemical substances released.

Fasca teaches a system and method for reviewing historical data and performing forecasting simulations relating to pollutant emissions from power plant, wherein various pollution reducing equipment are considered [0044].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Frankland to include evaluating the equipment that reduce chemical substances released, as disclosed in Fasca, because it would advantageously allow managers of the industrial facility to find the best solution to meet

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the pollution generation threshold to comply with governmental regulations, as specifically stated in Fascal [0006].

Claim 10. Fasca teaches said system, wherein investment effectiveness information is based on at least one item from among the processing performances, equipment costs, and operation costs of equipments that reduce chemical substances, which are provided by the enterprisers that manufacture the equipments which reduce the chemical substances [0066]. The motivation to combine Frankland and Fasca would be to advantageously identify the pollution reduction scenario that results in emissions below the mandated emissions caps and that has the least negative impact on the company's profits, as specifically stated in Fasca [0066].

Claim 11. Frankland teaches said system, wherein the equipment-specific release rate information provided by said enterprisers prescribes the relationship of the release amounts to each release-transfer destination of chemical substances that correspond to the input amounts of the materials that are input into equipments [0417]; [0419].

Claim 14. Frankland teaches tracking hazardous materials and wastes, including distribution and use of the materials at the facility; and evaluating environmental effects due to discharging the hazardous materials and wastes during the releases [0419], thereby obviously indicating monitoring environmental effects in the case the equipment is installed.

Claim 15. Frankland teaches said system, comprising: a plurality of equipment; and said database containing information related to investment and environmental compliance effectiveness [0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claim 16. Said system, comprising: a plurality of equipment; and said database contains information related to investment and environmental compliance effectiveness [0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claim 17. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Claim 18. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Response to Arguments

Applicant's arguments filed 8/12/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art fails to teach a plurality of equipment, it is noted that Frankland teaches said feature. Specifically, Frankland teaches regulatory tools useful in implementing EH&S compliance, including identification of all internal and external requirements in order that the *facility be allowed to operate*, and determining if, and how, proposed regulations will affect *facility operations* by providing access to material, *equipment* and process information to which the regulations may be applied [0421]. Frankland teaches facility as a whole, or combination of all type of equipment installed and operated at the facility. Furthermore, The examiner understands the word *equipment* as encompassing plural items used in operation or activity based on definition of this word in Merriam-Webster's Collegiate Dictionary; 10th ed. As per applicant's argument that the prior art does not teach the specifics of the equipment as disclosed in specification, it is pointed out that that said specific features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov
Patent Examiner
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A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

IB

9/15/2005